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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,810	09/27/2001	Gerhard Albrecht	HUBR- 1195 (10107427)	6995
24972	7590	11/05/2003	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			CHOI, LING SIU	
666 FIFTH AVE			ART UNIT	
NEW YORK, NY 10103-3198			PAPER NUMBER	

1733

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/937,810

**Applicant(s)**

ALBRECHT ET AL.

**Examiner**

Ling-Siu Choi

**Art Unit**

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1. 6) ☐ Other: .

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### **DETAILED ACTION**

1. This Office Action is in response to the Preliminary Amendment filed March 8, 2002. Claims 1-18 were canceled and claims 19-36 have been added. Claims 19-36 are now pending, wherein claims 19-28 are drawn to a copolymer; claims 29-34 a process to prepare the copolymer; claims 35-36 the use of a copolymer.

#### ***Claim Rejections - 35 USC § 112***

2. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

3. Claims 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 35-36 provide for the use of a copolymer, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

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Claims 35-36 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albrecht et al. (US 5,798,425).

The present invention relates to a copolymer based on radicals of unsaturated monocarboxylic or dicarboxylic acid derivatives and oxyalkylene glycol alkenyl ether, comprising

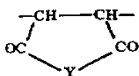
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(a)	from 51 to 95 mol%	$\begin{array}{c} \text{---CH}_2\text{---CR}^1\text{---} \\   \\ \text{COX} \end{array} \quad \begin{array}{c} \text{---CH}_2\text{---C---} \\   \\ \text{CH}_2 \\   \\ \text{COX} \end{array} \quad \begin{array}{c} \text{---CH}_2\text{---C---CH}_2 \\   \quad   \\ \text{O=C} \quad \text{C=O} \\   \\ \text{Y} \end{array}$
(b)	from 1 to 48.9 mol%	$\begin{array}{c} \text{---CH}_2\text{---CR}^3\text{---} \\   \\ (\text{CH}_2)_p\text{---O---}(\text{C}_m\text{H}_{2m}\text{O})_n\text{---R}^2 \end{array}$
(c)	from 0.1 to 5 mol%	$\begin{array}{c} \text{---CH---C---} \\   \quad   \\ \text{S} \quad \text{T} \end{array} \quad \begin{array}{c} \text{---CH---CH---CH---CH---} \\   \quad   \quad   \quad   \\ (\text{CH}_2)_z \quad \text{---V---} \quad (\text{CH}_2)_z \end{array}$
(d)	from 0 to 47.9 mol%	$\begin{array}{c} \text{---CH---CH---} \\   \quad   \\ \text{COO}_2\text{M} \quad \text{COX} \end{array} \quad \begin{array}{c} \text{---CH---CH---} \\   \quad   \\ \text{O=C} \quad \text{C=O} \\   \\ \text{Y} \end{array}$

(summary of claim 1)

Albrecht et al. disclose a copolymer based on oxyalkyleneglycol-alkenyl ether and unsaturated dicarboxylic acid derivatives, comprising (a) up to 50 mol% of an acrylic acid; (b) 1 to 89 mol% of component in the general formula of  $\text{---CH}_2\text{---CR}^3[(\text{CH}_2)_p\text{---O---}(\text{C}_m\text{H}_{2m}\text{O})_n\text{---R}^1]\text{---}$ ; (c) 0.1 to 10 mol% of component in the general formula of  $\text{---CHS---CR}^4\text{T---}$  or

and (d) 10 to 90 mol% of component in the formula of  $\text{---CH(COOM}_e\text{)---CHCOX---}$  or



(Claims 1 and 8).

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The difference between the present claims and the disclosure of Albrecht et al. is the requirement of the amount of component (a) from 51 to 95 mol% instead of up to 50 mol% in the present invention.

The caselaw holds that "a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties." *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Thus, it would have been obvious to one of ordinary skill in the art at the the invention was made to utilize the disclosure of Albrecht et al. and thereby obtain the present invention.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is (703)305-0887.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on (703)308-2450.

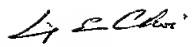
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-2351.

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Ling -Siu Choi

October 30, 2003